

**REMARKS/ARGUMENTS**

Claims 1-3, 7-14, and 18-21 have been previously presented and remain pending in the application. Claims 1 and 11 have been amended, claims 22 and 23 have been added, and claims 4-5 and 15-16 have been canceled. No new matter has been added. Examiner rejects claims 1-5, 7-16, and 18-21 under 35 U.S.C. §103 as being obvious. Applicants respectfully submit that claims 1-3, 7-14, and 18-23 are not obvious over the cited references.

**RESPONSE TO § 103 REJECTIONS**

In the Office Action mailed April 20, 2006, the Examiner rejected claims 1-5, 7-16 and 18-21 under 35 U.S.C. § 103 as being unpatentable over Abbott et al. (U.S. Patent 6,671, 808) (hereinafter, "Abbott"), and further in view of Burger (U.S. Pub. 2005/0060586) (hereinafter, "Burger").

**EACH AND EVERY CLAIM LIMITATION MUST BE TAUGHT OR SUGGESTED**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03

Applicant's independent claims include limitations not disclosed or suggested in Abbott nor Burger either alone or in combination. In particular, applicant's claims include ***"a storage medium coupled to the controller, wherein the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an***

Application. No. 09/683,919

Amendment Filed August 21, 2006

5

***identifier for the device and identifying where the device has been used."***

For example, Applicants' specification states that "information stored in the device can be stored in multiple layers: a first layer of information is specific to the individual; a second layer of information is the unique ID; and a third layer of information logs each location where the Security Key is used." (Specification, paragraph 21). Accordingly, this allows the device to be associated with the user's information and tracks each location where the device is used. A centralized data collection point (e.g., the secure key hub) may maintain a record indicating a device has an association with a particular user and including movement and activities of the particular user.

Abbott discloses a "personal key" with memory to store a user's personal information, such as digital certificates, passwords, and Internet cookies. For example, a user may load his personal information into the device's memory. However, the device disclosed by Abbott does not disclose or suggest "a storage medium coupled to the controller, wherein the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an identifier for the device and identifying where the device has been used," as claimed in independent claims 1 and 11. Similarly, Burger also fails to teach or suggest such a limitation.

As explained above Abbott and Burger fail to teach or suggest "a storage medium coupled to the controller, wherein the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an identifier for the device and identifying where the device has been used," either alone or in combination.

As such, Applicants respectfully submit that amended claims 1 and 11 are allowable over the cited references. Furthermore, dependent claims 2-3, 7-10, 12-14, and 18-23 are also allowable for the same reasons.

**NO SUGGESTION OR MOTIVATION TO COMBINE**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. 2143.01

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the Advisory Action of July 18, 2006, the Examiner maintains that it would have been obvious to one ordinary skill in the art at the time of invention to combine the teachings of Abbott and Burger. In particular, the Examiner cited lines 9 to 15 of column 7 of Abbott. However, after a careful review of this passage, Applicants submit that there is no teaching, suggestion nor motivation to combine with Burger in this passage.<sup>1</sup> In fact, because the security of the personal key itself is not important, there is no need for authentication of the personal key itself. As the passage indicates, Abbott is only

---

<sup>1</sup> "While the portability and utility of the personal key has many advantages, it also has one important disadvantage. It can be lost or stolen. This is especially troublesome because the personal key 200 (but not necessarily the personal key 200 itself) is highly important."

interested in the security of the stored information in the personal key. Thus, Abbott teaches away from combining with Burger.

Furthermore, Abbott is directed to "computer peripherals, and in particular to a personal key providing integrated password and digital certificate management, software security, and personal identification capability in a single compact package." In contrast, Burger is directed to a device for "producing, distributing, storing, and using the typical contents of a person's wallet, as well as the multiple, separate transaction authorization devices." There is no suggestion nor any mention in either reference to combine.

The mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

Thus, independent claims 1 and 11 are not obvious over Abbott in view of Burger. For the same reasons, claims 2-3, 7-10, 12-14, and 18-23 which depend from independent claims are also not obvious.

### CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Jong P. Hong at


Patent  
Attorney's Docket No: 76706-201701/US(OS-16/2376P)

(650) 328-8500.

If there are any additional charges, please charge Deposit Account No. 50-2638 for any fee deficiency that may be due.

Respectfully submitted,

Date: August 21, 2006

  
Jong P. Hong  
Reg. No. 51,290

GREENBERG TRAURIG, LLP  
CUSTOMER NUMBER 64,494  
1900 University Avenue, 5th Floor  
East Palo Alto, CA 94303  
Phone: (650) 328-8500  
Fax: (650) 328-8508  
E-Mail: hongj@gtlaw.com

Application. No. 09/683,919

Amendment Filed August 21, 2006

9